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IN THE
Supreme Court of the United States
OCTOBER TERM, 1996

ALPEX COMPUTER CORPORATION,
Petitioner,
v.
NINTENDO COMPANY, LTD. AND
NINTENDO OF AMERICA INC.,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

RESPONDENTS' BRIEF IN OPPOSITION

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QUESTION PRESENTED

Petitioner asserts that the decision of the court below is in conflict with this Court's intervening decision in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 117 S. Ct. 1040 (1997), which clarified the doctrine of prosecution history estoppel as a limitation on the common law doctrine of equivalents. There is no such conflict. The decision below did not involve an application of prosecution history estoppel to preclude a claim of infringement under the doctrine of equivalents. Rather, the decision of the court of appeals utilized the prosecution history to construe the claims at issue in a routine manner in accordance with established precedent which was unaffected by *Warner-Jenkinson*. Moreover, petitioner fails to acknowledge that the court of appeals' decision was independently based on the fact-bound determination that petitioner had failed to prove its claim for infringement. The following question is presented:

Whether, in determining the proper construction of a patent claim, a court may take into account statements made by the patent owner to the Patent Office concerning a related claim in the same patent that expressly limited the scope of an element that is common to both claims.

RULE 29.6 STATEMENT

Pursuant to Rule 29.6 of the Supreme Court, respondents state that Nintendo Company, Ltd. is the parent company of Nintendo of America Inc. and that there are no corporate subsidiaries (other than wholly-owned subsidiaries) of respondents.

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RESPONDENTS' BRIEF IN OPPOSITION

OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1a-16a) is reported at 102 F.3d 1214 (Fed. Cir. 1996). The decision of the district court (Pet. App. 17a-156a) is reported at 34 U.S.P.Q.2d 1167 (S.D.N.Y. 1994).

JURISDICTION

The judgment of the court of appeals was entered on November 6, 1996. A petition for rehearing and suggestion for rehearing *en banc* was denied on January 15, 1997. Pet. App. 157a. The petition for a writ of certiorari was filed on April 15, 1997. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATEMENT

A unanimous panel of the Court of Appeals for the Federal Circuit (Archer, Chief Judge, Rich and Newman, Circuit Judges) reversed a district court's judgment that the Nintendo Entertainment System ("NES") infringed petitioner Alpex Computer Corporation's patented device for assembling and displaying video images on a display screen. Although petitioner nominally seeks plenary review, its papers make clear that petitioner's aim is to secure an order granting certiorari, vacating the judgment below, and remanding the case ("GVR") in light of this Court's recent decision in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 117 S. Ct. 1040 (1997). Contrary to petitioner's argument, no aspect of this case implicated the issues of prosecution history estoppel addressed in *Warner-Jenkinson*. Indeed, no aspect of the court of appeals' decision in this routine patent case conflicts with any decision of this Court or any prior decision of the Federal Circuit. There is no basis for plenary review or a GVR in this case. The petition should simply be denied.

The court of appeals' decision was based on two independent grounds. First, the court concluded that, in light of petitioner's express distinction during the patent application process of its patented "bit-map" video display system from a prior art patent disclosing a "shift register-based" video display system, petitioner's patent claims could not now be construed to encompass the NES, which also utilizes a shift register-based structure. Second, the court held that petitioner had failed to prove infringement, since it introduced no competent evidence that the patented device and the NES were structurally equivalent or that they operated in substantially the same way.

Although *Warner-Jenkinson* and this case both have something to do with the relevance in an infringement case of the prosecution history of the allegedly infringed

patent, the fact that a case involves the same general area of law as a recent decision of this Court is not grounds to require the lower court to reconsider its judgment. Out of respect for lower courts, and recognizing the public interest in finality, this Court has observed that the "GVR power should be exercised sparingly" and will GVR only when (1) there is a "reasonable probability" that the decision "rest[ed] upon a premise that the lower court would reject if given the opportunity for further consideration," *and* (2) "it appears that such a redetermination may determine the ultimate outcome of the litigation. . . ." *Lawrence v. Chater*, 116 S. Ct. 604, 607, 609 (1996) (per curiam). Petitioner's argument fails both tests.

A GVR is unwarranted here since there is no reason to believe that this Court's intervening decision in *Warner-Jenkinson* would cause the court of appeals to reconsider its reliance on statements that petitioner made in the course of prosecuting its patent. Contrary to petitioner's characterization, *Warner-Jenkinson* does not speak to whether, in construing an allegedly infringed patent claim, a court may consider the prosecution history of a related claim in the same patent when the history sheds light on the definition and scope of an element that is common to both claims. It is well settled that statements made with respect to common elements apply with equal force to all of the claims in which such elements appear and that such elements must be consistently construed so that the public has clear notice of what constitutes infringing activity. Even if *Warner-Jenkinson* had cast doubt on that principle, a GVR would still be inappropriate because the court of appeals also concluded that petitioner failed at trial to introduce any competent evidence of infringement, and petitioner has not properly presented this fact-bound determination for review by this Court.

A. The Statutory Scheme Governing Patents And Claims For Infringement

The Patent Act, 35 U.S.C. § 101 *et seq.*, provides that inventors may obtain patents for various kinds of new and useful inventions. Section 112 of the Patent Act, 35 U.S.C. § 112, sets forth the required contents of a patent. A patent has two distinct parts: (1) a "specification," which contains a "written description of the invention, and of the manner and process of making and using it in such full, clear, concise and exact terms as to enable any person skilled in the art . . . to make and use the same"; and (2) one or more "claims," which "particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention." *Id.* The claims, which appear at the end of the patent in separately numbered paragraphs, define the scope of the patent owner's exclusive rights. 3 D. Chisum, *Patents* § 8.01 at 8-3 to 8-4 (1997). Each claim of a patent generally consists of one or more sub-paragraphs that are referred to as "elements" or "limitations." R. Faber, *Landis On Mechanics Of Patent Claim Drafting* §§ 9-10 (4th ed. 1996).

Patent infringement occurs when a person, without authority, makes, uses, or sells the patented invention during the term of the patent. 35 U.S.C. § 271(a). The determination of whether an accused device infringes a patent claim involves a two-step process. First, the patent claim must be construed to determine its proper scope and meaning. Claim construction is a question of law exclusively for the court. *Markman v. Westview Instruments, Inc.*, 116 S. Ct. 1384, 1387 (1996). Once a claim has been construed, the patent owner must prove that the accused device includes each of the elements in the claim to establish literal infringement. *Tanabe Seiyaku Co. v. United States Int'l Trade Comm'n*, 109 F.3d 726, 731 (Fed. Cir. 1997). The patent owner may also establish infringement under the common law doctrine of equivalents, which covers "products that go to the heart of the invention but avoid the literal language of the claim by

making an insubstantial change." *Markman*, 116 S. Ct. at 1388. Infringement under the doctrine of equivalents requires proof that a substantial equivalent of each element of the patent claim is present in the accused device. *General Mills, Inc. v. Hunt-Wesson, Inc.*, 103 F.3d 978, 984-85 (Fed. Cir. 1997).

A further principle of patent law is relevant to this case. Typically, the individual elements of a patent claim recite a structure that forms a part of the claimed invention. However, Section 112 ¶ 6 of the Patent Act, 35 U.S.C. § 112 ¶ 6, permits a patent applicant to express a claim element "as a means for performing a specified function without the recital of structure, material or acts in support thereof." Under this Section, a patent applicant "can describe an element of his invention by the result accomplished or the function served, rather than describing the item or element to be used." *Warner-Jenkinson*, 117 S. Ct. at 1048. Claim elements written as provided by Section 112 ¶ 6 are known as means-plus-function claim elements.

While elements written in means-plus-function format are written in broad language—the words literally appear to cover any means for performing the stated function—their scope is limited by Section 112 ¶ 6 to the corresponding structure disclosed in the patent specification and equivalents thereof. To establish literal infringement of a means-plus-function claim, the patent owner must prove that the accused device (1) performs the identical function recited in the means-plus-function claim element, and (2) performs that function using the structure disclosed in the patent specification or an equivalent structure. *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1388-89 (Fed. Cir. 1992).

An accused infringer is entitled to judgment as a matter of law when the patent owner fails to put forth evidence to support a finding that an element of the claim is present in the accused device, either literally or by a substantial equivalent. *Insituform Techs., Inc. v. Cat*

Contracting, Inc., 99 F.3d 1098, 1105 (Fed. Cir. 1996), *cert. denied*, 1997 WL 134332 (U.S. Apr. 28, 1997).

B. The '555 Patent And The NES

This case involved an allegation by petitioner that claims 12 and 13 of U.S. Patent No. 4,026,555 (the '555 patent) entitled "Television Display Control Apparatus" were infringed by the NES video game system sold by respondents, Nintendo Company, Ltd. and Nintendo of America Inc. (collectively "Nintendo"). Claims 12 and 13 require, as an element written in means-plus-function format, a "means for generating a video signal." Pet. at 3 nn.2-3. The one and only structure disclosed in the '555 patent specification for performing the function of generating a video signal is a particular type of structure known as a bit-map video display system. Pet. App. 4a, 37a-38a. The NES uses a different type of display system, known as a shift register-based display system. Pet. App. 4a-5a, 10a. The following facts are undisputed:

1. Various bit-map and shift register-based display systems had already been invented by others before the work in the early 1970s which led to the '555 patent. Pat. Doc. 74a-76a (describing prior art bit-map and shift register-based systems); *see also* Pet. at 19. These two kinds of display systems have mutually exclusive advantages and disadvantages. Pet. App. 3a-5a. A bit-map system permits access to and control over each individual location (or "pixel") on the display screen. Pat. Doc. 10a; Pet. App. 4a, 7a-8a; Pet. at 4. As described in the patent specification and emphasized by petitioner when prosecuting the patent, this ability is essential to allow the patented system to function as a "home intelligent terminal" (*i.e.*, a general purpose computer) which can create complex still pictures on the screen. Pat. Doc. 8a, 30a. In order to have the ability to create complex still pictures, however, the bit-map system must erase and rewrite each picture in memory in order to show the movement

of images. This causes the system to slow down. Pet. App. 4a. When the bit-map display system disclosed in the '555 patent is used for home video games, the system slows down as the number of moving objects increases. Pet. App. 4a-5a.

During prosecution of the '555 patent, in response to an objection from the United States Patent and Trademark Office (the "Patent Office") regarding application claim 1, petitioner distinguished its bit-map video signal generating structure (incorporated (by way of Section 112 ¶ 6) in the means-plus-function elements of application claim 1) from a previously issued patent to Okuda which used a shift register-based video display system. Pat. Doc. 74a-76a, 82a-83a; Pet. App. 7a-8a; Pet. at 6. Petitioner distinguished the bit-map video display structure from the shift register structure used by Okuda on the ground that bit-map video display systems can modify any single point on the television screen, while shift register-based systems like Okuda could not be randomly accessed and, therefore, could not selectively modify a single pixel on the television screen. Pat. Doc. 82a-83a; Pet. App. 9a-11a; Pet. at 6.

The bit-map video display system which petitioner distinguished from Okuda is the only means for generating a video signal that is disclosed in the '555 patent. That same structure is therefore necessarily incorporated (by way of Section 112 ¶ 6) as the "means for generating a video signal" element of claims 12 and 13. Thus, although application claim 1 differs from claims 12 and 13 in certain respects (*e.g.*, claim 1 relates to a generic "display control apparatus" while claims 12 and 13 relate to a game-playing device), they all share a common element, *i.e.*, the bit-map video display system disclosed in the '555 patent specification. Pat. Doc. 3a, 17a, 78a; Pet. App. 10a; Pet. at 3-4.[1]

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[1] Petitioner distinguished and amended application claim 1 in response to the examiner's citation of the prior art (Okuda) in

2. Nintendo designed the NES home video game system in the early 1980s. Pet. App. 5a. The NES generates video images on the screen using its own patented, custom-made integrated circuit called a picture processing unit ("PPU"). Pet. App. 5a. The PPU is a shift register-based system that retrieves pre-formed, horizontal slices of data and places each slice in one of eight shift registers capable of holding partial information for a small part of a single horizontal line of the video display. Pet. App. 5a.

In contrast to the bit-map system disclosed in the '555 patent, the NES shift register-based system directly constructs video images for the first time on the screen without using a bit-map memory which stores the entire image to be displayed. Pet. App. 5a. "It is undisputed that the NES video display system, using shift registers to process slices of images (as opposed to entire screens), is a faster means of displaying movement of images on the video screen than the bit-mapping of the RAM-based system of the '555 patent." Pet. App. 5a. As with the Okuda reference, however, the shift register-based NES cannot randomly access and control individual pixels on the display screen. Pet. App. 10a-11a.

C. Proceedings In The Trial Court

Prior to trial, the district court appointed a special master to assist the court in construing asserted claims 12 and 13. Petitioner's principal argument at trial, and the

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order to establish a basis for patentability of application claim 1. Pat. Doc. 74a-78a; Pet. App. 9a-10a; Pet. at 5. While it is true (as petitioner observes) that the Patent Office did not object to claims 12 and 13 based on Okuda (Pet. at 6, 17), petitioner's observation is a red-herring. Because claims 12 and 13 also contain additional elements not present in application claim 1 or the Okuda patent, the prior art would not have necessitated an amendment to those claims to establish patentability. *See Rowe v. Dror*, 1997 WL 189825, at *3 (Fed. Cir. Apr. 21, 1997) ("A prior art reference anticipates a claim only if the reference discloses, either expressly or inherently, every limitation of the claim.").

focus of most of its evidence, was that the "means for generating a video signal" element of claims 12 and 13 should not be construed to include a bit-map display system because such a bit-map display was specifically set forth as a part of claims 1-11 of the '555 patent and not specifically recited in claims 12 and 13. Pet. App. 40a, 147a, 153a. That argument, which ignored the provision of Section 112 ¶ 6 for incorporating the structure disclosed in the specification into means-plus-function claim elements, was rejected by the district court when it adopted the special master's recommended construction of claims 12 and 13 after the verdict. Pet. App. 26a-27a, 40a, 77a-78a. Alternatively, petitioner argued that the NES shift register-based display was "equivalent" to the bit-map display system disclosed in the patent. Pet. App. 40a. Nintendo consistently maintained that petitioner's evidence on this alternative theory was conclusory and thus, insufficient to sustain a verdict of infringement.

After the close of the evidence and before the court instructed the jury, the special master proposed a jury instruction construing the "means for generating a video signal" claim element, which, pursuant to Section 112 ¶ 6, correctly defined this means-plus-function element of claims 12 and 13 to include the bit-map video display system disclosed in the '555 patent specification. Pet. App. 6a. Alternatively, the special master proposed sending the issue of claim construction to the jury. *Id.* Over Nintendo's objection, the district court chose only to adopt the first sentence of the special master's claim construction instruction (which generally described the structural elements of the "means for generating a video signal" element of claims 12 and 13 by reference to a functional drawing (Figure 2) which accompanied the '555 patent specification) and left any further construction of the "means for generating a video signal" to the jury. Pet. App. 6a-7a. The jury returned a verdict of infringement. Immediately following the jury verdict, the district court adopted the special master's proposed claim

construction in its entirety. Pet. App. 7a, 26a-27a. After a trial on damages, the jury awarded petitioner damages of over $208 million.

Nintendo moved for judgment as a matter of law ("JMOL") on the issue of infringement. In support of its motion, Nintendo argued that petitioner's evidence of infringement was insufficient, and that the verdict of infringement could not be reconciled with petitioner's own distinction during prosecution of the patent of its bit-map display structure from the Okuda shift register-based display. With respect to the latter argument, Nintendo explained that because the bit-map display structure was an element common to application claim 1 and claims 12 and 13, petitioner's statements about this structure applied with equal force to claims 12 and 13 and limited the scope of those claims to exclude shift register-based systems like the NES. Pet. App. 154a-155a.[2]

The special master had recommended that the district court not use petitioner's statements in the prosecution history distinguishing its bit-map display structure from Okuda for purposes of prosecution history estoppel with respect to claims 12 and 13 because these statements had been made in the context of a challenge to the patentability of application claim 1. Pet. App. 142a, 154a-156a. The special master did not consider the relevance of the prosecution history as a guide to construing claims 12 and 13, even though the same video generation element incorporated in application claim 1 was present in claims 12 and 13. The district court similarly failed to

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[2] In addition to its motion for JMOL based on the bit-map versus shift register distinction, Nintendo also challenged two other issues of claim construction. The district court denied Nintendo's motion for JMOL on these additional grounds. Because the court of appeals reversed based on the bit-map versus shift register distinction, it did not reach these other issues. Pet. App. 7a n.1. Nintendo also appealed the district court's judgment that Nintendo had not proven claims 12 and 13 to be invalid. The court of appeals affirmed this portion of the distirct court's judgment. Pet. App. 16a.

consider this prosecution history in construing the scope of the asserted claims. Pet. App. 26a-27a.

The district court concluded that there was sufficient evidence to support the infringement verdict, denied Nintendo's motion for JMOL and entered judgment in the amount of $253,641,445 (the amount of the jury verdict plus pre-judgment interest) in favor of petitioner. Pet. App. 2a. The Federal Circuit reversed. Pet. App. 1a-16a.

D. The Decision Of The Federal Circuit

1. In reviewing the judgment that the NES infringed claims 12 and 13 of the '555 patent, the Federal Circuit first construed the meaning and scope of the patent claims at issue in light of the claim language, the patent specification, and the prosecution history in accordance with established principles of patent law. *See Markman*, 116 S. Ct. 1384 (*affirming*, 52 F.3d 967, 979 (Fed. Cir. 1995)); Pet. App. 6a-11a. Pursuant to Section 112 ¶ 6, in construing the "means for generating a video signal" element of claims 12 and 13, the Federal Circuit referred to the structure corresponding to this element set forth in the patent specification, *i.e.*, the bit-map video display system. Pet. App. 3a, 10a-11a.

The Federal Circuit correctly determined that, since the same video display system structure is an element in application claim 1 and in issued claims 12 and 13, petitioner's statements during patent prosecution distinguishing this bit-map structure from Okuda in connection with application claim 1 apply with equal force in construing this same element in issued claims 12 and 13. Pet. App. 7a-10a. Observing that petitioner had "distinguished Okuda before the [Patent Office] based on the structural difference of a RAM-based versus a shift register-based video display system," the court could "discern no reason why prosecution history relating to the structure of the video display in the means-plus-function limitations of claim 1 is not pertinent to the same structure of the same

display system in the means-plus-function limitations of claims 12 and 13." Pet. App. 10a.

In short, the structural and functional differences which petitioner had pointed out between its video display system and that of Okuda did not depend upon the particular applications of the systems; the limitations and benefits of the bit-map video display system structure were present irrespective of the application for which the structure was employed. Holding petitioner to the indisputable public patent record, the Federal Circuit concluded that, having distinguished its bit-map system from Okuda's shift register-based system during prosecution of the patent, petitioner's "claims *cannot now be construed to cover* the NES, which possesses the same structural and functional traits as Okuda." Pet. App. 11a (emphasis added).

2. The court also concluded, in the alternative, that the judgment could not stand because petitioner had failed to prove essential elements of its claim for infringement. In order to establish literal infringement of claims 12 and 13, petitioner had the burden of proving, by substantial, non-conclusory evidence, that (1) the NES shift register-based video display system performed the identical function set forth in the means-plus-function claim element, *i.e.*, the NES generated a video signal; and, (2) that the NES display system was the same as or structurally equivalent to the bit-map display disclosed in the patent specification which corresponds to the "means for generating a video signal." 35 U.S.C. § 112 ¶ 6; *Carroll Touch, Inc. v. Electro Mechanical Sys., Inc.*, 15 F.3d 1573, 1578 (Fed. Cir. 1993). In the court of appeals, the literal infringement analysis focused on whether petitioner introduced sufficient evidence for the jury to conclude that the two systems were structurally equivalent.[3]

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[3] There was no dispute that the NES performed the claimed function. Pet. App. 38a. Like the '555 patent, the NES generated a video signal to create a display on the screen. It was also undisputed that the NES shift register-based video display system and the claimed bit-map video display system were not the same. Pet. App. 35a.

The Federal Circuit reviewed the factual record to determine whether the petitioner had offered any evidence that the accused NES was structurally equivalent to the bit-map video display system claimed in the '555 patent.[4] It found that, while petitioner's technical expert, Ronald Milner, testified that, in his view, the bit-map structure disclosed in the '555 patent and the shift register structure of the accused NES were "equivalent," his testimony (that both video display systems store data and will eventually display an image on the whole screen) related only to the fact that both systems perform the same *function* of displaying an image on a screen, and that Mr. Milner failed to offer any non-conclusory testimony on the crucial contested issue of whether the two systems were *structurally* equivalent. Pet. App. 13a. In accord with Section 112 ¶ 6 and established precedent, the Federal Circuit concluded that petitioner's failure to present evidence of structural equivalency required reversal of the judgment of literal infringement: "[B]ecause the testimony relied upon by Alpex to establish infringement under § 112, ¶ 6, was based only on a functional, not a structural, analysis, we conclude the court erred in sustaining the jury verdict of literal infringement." Pet. App. 13a.

The Federal Circuit found a similar failure of proof with respect to petitioner's allegation of infringement under the doctrine of equivalents. The purpose of the doctrine of equivalents is to prevent others from evading the words of a patent claim by merely making unimportant and insubstantial changes and substitutions in the patent. *Warner-Jenkinson*, 117 S. Ct. 1046-47, *citing Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605 (1950); *see also* Pet. App. 16a. While there is

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[4] "In the context of section 112 . . . an equivalent results from an insubstantial change which adds nothing of significance to the structure . . . disclosed in the specification." *Valmont Indus., Inc. v. Reinke Mfg. Co.*, 983 F.2d 1039, 1042 (Fed. Cir. 1993). Conclusory expert testimony on this issue is insufficient to prove infringement. *See, e.g., Johnston v. IVAC Corp.*, 885 F.2d 1574, 1578 (Fed. Cir. 1989).

no single test for proving infringement under the doctrine of equivalents, one recognized test, often referred to as the "triple identity test," requires that the patent owner prove that the accused device (1) performs substantially the same function, (2) in substantially the same way, (3) to achieve substantially the same result as the relevant claim element in issue. *Valmont*, 983 F.2d at 1043. Petitioner specifically relied on the triple identity test to prove infringement under the doctrine of equivalents in this case. Pet. App. 14a. In the district court and on appeal, a major contested issue was whether the shift register-based display system of the NES operated in substantially the same way as the claimed bit-map display system.

The Federal Circuit again assessed the record to determine whether petitioner had proven that the two systems operated in substantially the same way. Pet. App. 13a-16a. The Federal Circuit found that, not only was Mr. Milner's testimony on this issue "merely conclusory as acknowledged by the district court," but it was confined to an assertion that the NES shift register-based video display system can achieve substantially the same functional result as the claimed bit-map video display system. Pet. App. 14a-16a. This testimony could not support a conclusion that the claimed bit-map display system and the NES shift register-based display system operate in substantially the same way. Pet. App. 14a-16a. Nor did Mr. Milner offer any analysis of the differences between the video display systems at issue to support his bare conclusion that these differences were "insubstantial" or "insignificant." Pet. App. 14a-16a. The Federal Circuit concluded that "[t]he evidence in this case, therefore, does not support a finding of infringement under the doctrine of equivalents. The evidence fails to establish that the claimed and accused devices operate in the same way or that the differences between them are insubstantial." Pet. App. 16a. The Federal Circuit denied petitioner's request for rehearing and suggestion for rehearing *en banc*. Pet. App. 157a.

REASONS TO DENY THE WRIT

Petitioner argues that the Federal Circuit's consideration of statements made by petitioner during its prosecution of the patent—differentiating its bit-map-based video display system from Okuda's prior art shift register-based system—conflicts with this Court's holding in *Warner-Jenkinson*. The argument proceeds in two steps. According to petitioner (1) even though the Federal Circuit explicitly considered the prosecution history only in connection with its construction of the scope of claims 12 and 13, the court of appeals' decision should nonetheless be understood to have been based *sub-silentio* on prosecution history estoppel (a defense to which the court adverted but on which it declined to rule, *see* Pet. App. 8a-9a); and, (2) *Warner-Jenkinson* should be read to have established that "prosecution history estoppel applies only where the specific claims at issue were narrowed during prosecution" (Pet. at 1) (an issue that was neither before the Court nor addressed by it).

The petition for certiorari should be denied. The decision of the court of appeals was based on a routine application of well established principles of claim construction, not on prosecution history estoppel. As a result, *Warner-Jenkinson*'s teaching regarding prosecution history estoppel has no application here. Even if the decision below were understood in estoppel terms, however, the notion that a patent holder may be held to account for statements that it has made during patent prosecution about a structural element that is incorporated by reference (via Section 112 ¶ 6) into a claim when it later attempts to recharacterize that same structural element to its advantage in litigation respecting a related claim that incorporates the same element does not conflict in any way with *Warner-Jenkinson* or any other decision of this Court. The judgment of the court of appeals, moreover, was independently grounded in the court's finding that petitioner's conclusory evidence of structural equivalence was insufficient as a matter of law, a fact-bound finding which

petitioner has not properly presented for review by this Court.

Petitioner's failure of proof is also fatal to its request for a GVR. To warrant a GVR based on an intervening decision of this Court, there must be a "reasonable probability that the decision below rests upon a premise that the lower court would reject if given the opportunity for further consideration," and it must appear "that such a redetermination may determine the ultimate outcome of the litigation." *Lawrence*, 116 S. Ct. at 607. Nothing contained in the petition or in *Warner-Jenkinson* would cause the Federal Circuit to decide the issue of whether there was a failure of proof differently.

The standards of proof required for a finding of infringement have long been established and nothing in *Warner-Jenkinson* calls these settled principles into question. To the contrary, the Court made clear in *Warner-Jenkinson* that its decision had no impact on the determination of the proper analytical framework for evaluating assertions of equivalence, as to which the Court explicitly deferred to the "special expertise" of the Federal Circuit. *Warner-Jenkinson*, 117 S. Ct. at 1054.

Petitioner's assertions that substantial evidence existed to support the judgment of infringement were vigorously argued in the Federal Circuit. The Federal Circuit carefully considered the record in deciding to order judgment for Nintendo. Petitioner asked the entire Federal Circuit for rehearing *en banc*, again raising the issue of the sufficiency of the evidence. The Federal Circuit requested full supplemental briefing from both parties and then denied the petition. Pet. App. 157a.

I. THIS COURT'S DECISION IN *WARNER-JENKINSON* PROVIDES NO BASIS FOR REVIEW OR A GVR IN THIS CASE

Petitioner asserts that *Warner-Jenkinson* established a strict rule that prosecution history estoppel can only apply with respect to the specific claim as to which an amendment is made during prosecution. Pet. at 1. In petitioner's view, the Federal Circuit violated that rule in this case by applying prosecution history estoppel to bar petitioner from asserting infringement of the claims in suit (claims 12 and 13) based upon statements that petitioner made during patent prosecution with respect to application claim 1. Petitioner has mischaracterized both the holding of *Warner-Jenkinson* and the basis for the decision below.

1. In *Warner-Jenkinson*, the Court reaffirmed the vitality of the common law doctrine of equivalents. At the same time, however, the Court recognized that an overbroad application of the doctrine of equivalents conflicts with the definitional and public-notice functions of the statutory claiming requirement.[5] Because of that concern, the Court clarified that the doctrine of equivalents must be applied to each individual element of the claim, rather than to the claim as a whole. *Warner-Jenkinson*, 117 S. Ct. at 1048-49 ("Each element contained in a patent

[5] The Patent Act requires that the patent claims, which describe the metes and bounds of the actual invention, use language "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 U.S.C. § 112 ¶ 2. This language is designed to ensure that the public has available the information needed to identify infringing conduct. This Court in both *Warner-Jenkinson* and *Markman* underscored the importance of the public-notice function of the claiming requirement in providing competitors with a public patent record upon which they can rely to understand the scope of patent claims. *Warner-Jenkinson*, 117 S. Ct. at 1048-49; *Markman*, 116 S. Ct. at 1396 ("[t]he limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public.").

claim is deemed material to defining the scope of the patented invention, and thus the doctrine of equivalents must be applied to individual elements of the claim, not to the invention as a whole.").

Warner-Jenkinson also reaffirmed that prosecution history estoppel serves as a limit on the doctrine of equivalents. Prosecution history estoppel prevents the patent owner from recapturing subject matter which it surrendered during prosecution of the patent. The Court observed that an estoppel arises when a claim is amended during patent prosecution to avoid prior art, or otherwise to address a specific concern that arguably would have rendered the claimed subject matter unpatentable. *Id.* at 1049-50. Where the reason for an amendment during patent prosecution is unclear, *Warner-Jenkinson* established a rebuttable presumption that the amendment was related to patentability (and would therefore trigger the application of prosecution history estoppel to bar an assertion of equivalence with respect to the subject matter of the amendment). *Id.* at 1051.

In *Warner-Jenkinson,* the same claim at issue in the infringement action had been amended during patent prosecution. *Warner-Jenkinson* did not concern, and thus did not address (much less overrule) the well settled proposition that statements made in the prosecution history about a claim element that is common to several claims in the same patent apply with equal force in construing that element in all of the claims containing that element:

> [I]n the context of literal infringement, it is well-settled that identical claim terms used in different claims must be interpreted consistently. . . . Similarly, under the doctrine of equivalents, we see no reason to assign different ranges of equivalents for the identical term used in different claims in the same patent, absent an unmistakable indication to the contrary. This is particularly so because, during prosecu-

tion, the applicant may amend his claims to avoid the risk of estoppel.

American Permahedge, Inc. v. Barcana, Inc., 105 F.3d 1441, 1445 (Fed. Cir. 1997). The Federal Circuit has reiterated this established principle since this Court's decision in *Warner-Jenkinson*. *See CVI/Beta Ventures, Inc. v. Tura LP*, 1997 WL 214809, at *8 (Fed. Cir. May 1, 1997) ("We have stated that 'arguments made during prosecution regarding the meaning of a claim term are relevant to the interpretation of that term in every claim of the patent absent a clear indication to the contrary.' "), *quoting Southwall Techs. Corp. v. Cardinal IG Co.*, 54 F.3d 1570, 1579 (Fed. Cir.), *cert. denied*, 116 S. Ct. 515 (1995). Petitioner's characterization of *Warner-Jenkinson* as having rejected that principle (Pet. at 16) is entirely without merit.[6]

2. There is no conflict, nor any tension, between *Warner-Jenkinson* and Federal Circuit's decision below. *Warner-Jenkinson* has no application to this case, which did not involve the use of prosecution history estoppel to foreclose application of the doctrine of equivalents. In this case, the court of appeals simply looked to the prosecution history of the '555 patent, along with the claim language and the patent specification, to construe the claims in suit. That approach was fully consistent with this Court's teaching in *Markman*, 116 S. Ct. 1384. The Federal Circuit concluded that petitioner's claims could not be construed to cover the NES, which indisputably possesses the same structural and functional traits as the Okuda shift register-based video display system that petitioner specifically and explicitly distinguished during patent prosecution. In accordance with this Court's decision

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[6] *See also Fonar Corp. v. Johnson & Johnson*, 821 F.2d 627, 632 (Fed. Cir. 1987) (the meaning of a term in a claim must be defined in a manner that is consistent with its appearance in other claims in the same patent), *cert. denied*, 484 U.S. 1027 (1988).

in *Markman*, the Federal Circuit found that the public was entitled to rely on the public patent documents, which established the scope of petitioner's claims, and that the district court erred in finding that the NES literally infringed the '555 patent.

Petitioner argues that the Federal Circuit's decision can only be understood in terms of estoppel. That is incorrect. As the Federal Circuit observed, it is well established that the prosecution history is as relevant to claim construction as it is to estoppel:

> Prosecution history is relevant not only for purposes of prosecution history estoppel but also for construing the meaning and scope of the claims. [citations omitted]. '[T]he prosecution history of all claims is not insulated from review in connection with determining the fair scope of [a] claim. . . . To hold otherwise would be to exalt form over substance and distort the logic of this jurisprudence, which serves as an effective and useful guide to the understanding of patent claims.'

Pet. App. 9a, quoting *Builders Concrete, Inc. v. Bremerton Concrete Prods. Co.*, 757 F.2d 255, 260 (Fed. Cir. 1985); *accord American Permahedge*, 105 F.3d at 1445 (where an element in a claim is specifically and unambiguously defined as excluding an accused structure, that limitation on claim scope must be given effect in claim construction); *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1573 (Fed. Cir. 1997); *Jonsson v. Stanley Works*, 903 F.2d 812, 818-19 (Fed. Cir. 1990).

Even if the Federal Circuit's decision could be viewed in estoppel terms, it would involve a separate branch of prosecution history estoppel, commonly known as "estoppel by argument." It has long been settled that unambiguous statements by the patent applicant can operate as an estoppel to foreclose infringement by equivalence, even where the applicant has not amended the claims and even

where the statements are not necessary for patentability.[7] *Warner-Jenkinson* did not involve an estoppel by argument. The issue presented in *Warner-Jenkinson* was the effect of an unexplained claim amendment.

3. Despite petitioner's efforts to make out a case for a GVR, it is clear that the Federal Circuit's decision is fully consistent with the principles announced by this Court in *Warner-Jenkinson*. The Federal Circuit properly analyzed the question of infringement under the doctrine of equivalents on an element-by-element basis. The bit-map video signal generation structure is a common element in all of the relevant claims. Petitioner now suggests that the range of equivalents for this claim element should vary from claim to claim depending upon the particular application that is contemplated for the structure in each claim. As set forth above, consistent precedent recognizes the sound principle that claim elements common to multiple claims must be consistently construed, and statements in the prosecution history with respect to these common elements apply equally to these elements in all claims.

This Court recognized in *Warner-Jenkinson* that the doctrine of equivalents must be analyzed on an element-by-element basis rather than on the basis of alleged similarities or differences between the accused device and the claim as a whole in which the elements appear. Petitioner's approach, that would determine equivalence claim-by-claim rather than element-by-element, was specifically rejected in *Warner-Jenkinson* because it would lead to an unpredictable application of the doctrine of equivalents and, poten-

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[7] *See, e.g., Hoganas AB v. Dresser Indus., Inc.*, 9 F.3d 948, 952-53 (Fed. Cir. 1993); *Texas Instruments Inc. v. United States Int'l Trade Comm'n*, 988 F.2d 1165, 1174 (Fed. Cir. 1993); *Kinzenbaw v. Deere & Co.*, 741 F.2d 383, 389 (Fed. Cir. 1984), *cert. denied*, 470 U.S. 1004 (1985); 5 D. Chisum, *Patents* § 18.05[2][c] at 274 (1997 Supp.) ("Decisions of the Court of Appeals for the Federal Circuit . . . indicate that arguments and assertions made during prosecution may give rise to prosecution history estoppel.").

tially, an improper expansion of claim scope. *Warner-Jenkinson*, 117 S. Ct. at 1049.

The long and short of this case is that petitioner's own statements in the public patent record confirmed what the evidence independently demonstrated: that the two video display systems are not structurally equivalent and do not operate in substantially the same way. The Federal Circuit's ruling was correct and consistent with *Warner-Jenkinson*. There is no reason for further review by this Court.[8]

II. NEITHER REVIEW NOR GVR ARE APPROPRIATE BECAUSE THE FEDERAL CIRCUIT FOUND AS AN ALTERNATIVE, INDEPENDENT GROUND FOR REVERSAL THAT PETITIONER HAD FAILED TO PRODUCE SUFFICIENT EVIDENCE OF INFRINGEMENT

The Federal Circuit reviewed the evidentiary record below and found that petitioner failed to introduce evidence that could support a jury verdict of literal infringement or infringement under the doctrine of equivalents. While petitioner argues throughout its petition that the Federal Circuit wrongly evaluated the evidence, it has not asked this Court to review that issue, and, therefore, cannot rely on it

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[8] This case stands in sharp contrast to the cases in which this Court has GVR'd in the wake of *Warner-Jenkinson*: *Hughes Aircraft Co. v. United States*, 86 F.3d 1566 (Fed. Cir. 1996), *cert. granted, vacated and remanded*, 1997 WL 71435 (U.S. Apr. 21, 1997); *Honeywell, Inc. v. Litton Sys., Inc.*, 87 F.3d 1559 (Fed. Cir. 1996), *cert. granted, vacated and remanded*, 117 S. Ct. 1240 (1997); and, *Shoketsu Kinzoku Kogyo Kabushiki Co. v. Festo Corp.*, 72 F.3d 857 (Fed. Cir. 1995), *cert. granted, vacated and remanded*, 117 S. Ct. 1240 (1997). In *Hughes* and *Honeywell* the Federal Circuit upheld a finding of infringement under the doctrine of equivalents seemingly based on the similarities in the accused processes and the overall claimed inventions, without engaging in an element-by-element comparison mandated by *Warner-Jenkinson*. *Hughes*, 86 F.3d at 1579-80; *Honeywell*, 87 F.3d at 1579. In *Shoketsu*, the Federal Circuit declined to apply prosecution history estoppel where

as a basis for certiorari. Even if petitioner's complaints regarding the Federal Circuit's evaluation of the record in this case were properly presented, these complaints are fact-bound and do not merit this Court's review. *United States v. Johnston*, 268 U.S. 220, 227 (1925) ("We do not grant a certiorari to review evidence and discuss specific facts."), *cited with approval in Texas v. Mead*, 465 U.S. 1041, 1043 (1984); Rule 10 of the Supreme Court ("A petition for a writ of certiorari is rarely granted when the asserted error consists of erroneous factual findings. . . .").[9]

Petitioner attempts to avoid the consequence of the existence of an independent, fact-bound basis for the Federal Circuit's decision by suggesting that the court's supposed error in construing patent claims 12 and 13 in view of the prosecution history infected its assessment of the evidence bearing on the issue of infringement. *See* Pet. at 20-23. There is no basis for that suggestion. Separate and apart from its decision on the issue of claim construction, the Federal Circuit found that petitioner failed at trial to produce any competent evidence of structural equivalence, an essential element required for a determination of literal infringement under Section 112 ¶ 6. Pet. App. 13a. As discussed above, the standards of proof of literal infringement under Section 112 ¶ 6 are well established and unaffected by this Court's decision in *Warner-Jenkinson*. Petitioner simply failed to meet those standards in this case.

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the reason the patentee had amended the claim in suit was unclear, without applying the rebuttable presumption now established by *Warner-Jenkinson* that such amendment was related to patentability. *Shoketsu*, 72 F.3d at 864.

[9] The Federal Circuit fully considered petitioner's factual arguments with respect to the testimony of Mr. Milner, Mr. Kirschner and Dr. Ward in the original briefing and on petitioner's request for rehearing *en banc*. *See* Pet. at 22-23.

Similarly, separate and apart from its decision on the issue of claim construction, the Federal Circuit found that petitioner had failed at trial to produce any competent evidence that the claimed structure and the accused device operated in the same way or that the differences between them were insubstantial, an essential element required for a determination of infringement under the doctrine of equivalents. Pet. App. 16a; *Warner-Jenkinson*, 117 S. Ct. at 1054. Again, nothing in *Warner-Jenkinson* altered the essential elements for proof of infringement under the doctrine of equivalents.

To the extent that petitioner argues (Pet. at 14-15) that the decision below improperly determined the issue of equivalence under Section 112 ¶ 6 and the doctrine of equivalents as a matter of law, it mischaracterizes the decision below. The Federal Circuit found, after examining the factual record, that the petitioner had produced no competent evidence of equivalence under either standard and, for that reason, properly dismissed this case as a matter of law. That is how it should be. This Court stated in *Warner-Jenkinson* that "[w]here the evidence is such that no reasonable jury could determine two elements to be equivalent, district courts are obliged to grant partial or complete summary judgment." 117 S. Ct. at 1053 n.8. The Court added that, "[i]f there has been a reluctance to do so by some courts due to unfamiliarity of the subject matter, . . . the Federal Circuit can remedy the problem." *Id.* This is precisely what occurred here.

Because the Federal Circuit's judgment is supported by its independent, alternative holding that there was no substantial evidence of infringement, this case would not be appropriate for plenary review and a GVR would serve no purpose.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit should be denied.

Respectfully submitted,

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